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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/608,673

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Chul Chung

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02/04/2009

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EXAMINER

GREENE, DANIEL LAWSON

ART UNIT

PAPER NUMBER

3694

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/608,673	<b>Applicant(s)</b> CHUNG, CHUL	
	<b>Examiner</b> DANIEL L. GREENE	<b>Art Unit</b> 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

1. Claims 1-16 are pending with claims 4-7 withdrawn. Applicant's supplemental response received 10/9/2008 is acknowledged and has been acted upon in the instant Office action. An action on the merits of claims 1-3 and 8-16 follows.

#### ***Response to Amendment***

2. Applicant's amendments to the specification has obviated the objections set forth in sections 4 and 5 of the previous Office action mailed 7/8/2008. Accordingly they are withdrawn.

#### ***Response to Arguments***

**3. Applicant's arguments filed 10/09/2008 with respect to the 35 USC 101 rejection set forth in section 6 of the previous Office action have been fully considered but they are not persuasive.**

The claimed invention is not tied to a particular machine or apparatus and does not transform a particular article to a different state or thing.

See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir 2008)

Applicant's invention appears to be nothing more than insignificant extra-solution activity which has been, up to this point, performed manually by hand.

Accordingly said rejection is sustained and incorporated herein by reference.

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**4. Applicant's arguments filed 10/09/2008 with respect to the 35 USC 102 rejection set forth in section 8 of the previous Office action have been fully considered but they are not persuasive.**

First, the Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

As stated in said section 8, the rejection is based upon the May reference in its entirety. The Examiner has provided specific citation for the benefit of applicant.

May clearly sets forth in, for example, Col. 1 lines 35-50, that automated systems provide for greater accuracy.

## BACKGROUND OF THE INVENTION

In recent years, commodity exchanges have become more 35  
and more dependent upon electronic trading systems. The  
older manual methods by which trades were conducted have  
given way to advanced computer systems that have gener-  
ally mimicked the manual methods of old. These relatively  
new electronic trading systems have many advantages over 40  
the manual systems, including the ability to provide such  
features as greater accuracy, ~~reduced labor cost~~, real time  
market information, more efficient communications over  
greater distances, and automated record keeping. However,  
because the markets in which these commodities are being 45  
traded are so vastly different from the descriptions of the  
instruments to transaction methodologies, electronic trading  
systems are generally limited to a specific market such as  
futures, cash, oil, stock, securities, etc., and sometimes even  
to a specific commodity within a single market. 50

Further, Col. 39, lines 36-40 teach that the trader verifies accuracy by selecting  
the Apply button, which causes the system to verify the inputted portfolio.

Figure 26 of May provides for verifying the trade eligibility of the respective first  
and second users, which inherently includes screening for accuracy because if the user is  
ineligible to participate then the process stops.

Another way to look at the limitation "screening for accuracy" may be found  
within the input mechanism itself, i.e. Figure 14A requires a price and a quantity. If  
either of these is missing or inaccurate, the system/process cannot continue because  
improper parameters have been entered.

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It must be noted that applicant's claims fail to set forth a specific order in which the steps must be performed. Accordingly, as long as the reference performs said step at some point in time, it reads on the claimed invention.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 1-3 and 8-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 1, 8 and 11 are vague, indefinite and incomplete in what all is meant by and encompassed by the phrase “using said outputted data record...to support an execution...” (emphasis added). The limitation “to support an execution” does not appear to connote any particular “support” whatsoever, hence the metes and bounds of the claim are undefined as one of ordinary skill in the art would not know when they would potentially infringe on the claimed subject matter if it were ultimately patented.

Although the claims are interpreted in light of the specification, limitations from the specification are NOT imported into the claims. The Examiner must give the claim language the broadest reasonable interpretation the claims allow.

See MPEP 2111.01, which states

While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims **must be interpreted as broadly as their terms reasonably allow**. In re American Academy of Science Tech

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Center, F.3d, 2004 WL 1067528 (Fed. Cir. May 13, 2004)

Claims 2, 3, 9, 10 and 12-16 are rejected for being dependent on a rejected base claim.

**The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.**

***Claim Rejections - 35 USC § 102***

**7. Claims 1-3 and 8-16 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by U.S. Patent 6,317,727 B1 to May for the reasons set forth in section 8 of the previous office action mailed 7/8/2008.**

See the discussion of this topic in section 4 above.

***Claim Rejections - 35 USC § 103***

**8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**9. Claims 1-3 and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over May as applied to claims 1-3 and 8-16 above and further in view of U.S Patent 5,890,140 to Clark et al.**

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May discloses applicant's invention as set forth above and in the previous Office action mailed 7/8/2008.

If applicant is of the opinion that May does not disclose verifying or screening data for accuracy, then resort may be had to Clark et al. to show it is old and well known to do so at various points in a financial transaction sequence. See for example, Fig 3., (check ID and Password, check sequence #, etc.), Figures 16, 18, 19 and associated descriptive text, etc. See specifically Col. 20, lines 7+.

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the system and method of May to include error checking or verifying or screening the inputted data for accuracy for the benefits thereof, i.e. ensuring that the data in a financial transaction is indeed correct such that the proper parties to said transaction perform the intended actions. That is, it is obvious to check ones work to eliminate/minimize errors during the input of data.

Further, it is notoriously old and well known for financial instruments to be verified accurate before processing because, for example, in the 1990's personal checks used at a local merchant required some form of identification (ex. drivers license) which was transcribed by the clerk onto said check in order to continue processing. This is of course the manual version of the claimed invention, but again ,there is no patentability in merely automating a process that was previously performed by hand. See for examples, *In re Venner*, 120 USPQ 192 (CCPA 1958) and *In re Rundell*, 9 USPQ 220

“It is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result.”



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“If a new combination of old elements is to be patentable, the elements must cooperate in such manner as to produce a new, unobvious, and unexpected result. It must amount to an invention”

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

11. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL L. GREENE whose telephone number is (571)272-6876. The examiner can normally be reached on Mon-Thur.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. L. G./

Examiner, Art Unit 3694  
20090201

/James P Trammell/

Supervisory Patent Examiner, Art Unit 3694